



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,344	06/26/2003	Ajay Mirtal	08212/0200294-US0	9288
38879	7590	07/12/2005	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-6257			DINH, MINH	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,344

Applicant(s)

MIRTAL ET AL.

Examiner

Minh Dinh

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 04/19/2005. Claims 1, 3-4, 8, 11-12, 16 and 19-22 have been amended; claim 15 has been cancelled; claims 23-24 have been added.
2. Claim 22 has been amended; however, the status of the claim is indicated as "Original". Appropriate correction is required in the next response.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 3-4, 8, 11, 16 and 22 have been considered but are not persuasive. Applicant's amendments have necessitated a new search and new grounds of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5-9, 13-14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl et al (6,223,291) in view of Sudia (US 2005/0114666).

Regarding claims 1 and 7-8, Puhl discloses a system and method comprising: a client computer configured to provide an electronic request for a license certificate that includes information associated with an end user and an identifier associated with a software product (col. 6, lines 16-32); a Web server configured to receive the electronic request and to employ the information to authenticate the end-user (col. 6, lines 16-32); a Licensing Authority configured to digitally sign the license certificate; and the client computer configured to receive the license certificate, wherein the license certificate enables access to the software product (col. 6, lines 16-32; col. 3, lines 1-10). Puhl discloses a certificate revocation list (CRL) listing license certificates that have been revoked (col. 7, lines 5-7); however, Puhl does not disclose how to access the CRL. Sudia discloses a certificate having an extension field that includes a URL to a CRL responder that provides revocation status information for a certificate (paragraphs 0381-0382, 0386); the revocation status information for a certificate is functionally equivalent to an additional license restriction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl license certificate to have an extension field that includes a URL to a CRL responder that provides revocation status information for a certificate, as taught by Sudia. The motivation for doing so would have been to facilitate checking of revocation status information for a certificate.

Regarding claims 2 and 9, Puhl further discloses that the Licensing Authority operates substantially similar to a Certification Authority in a Public Key Infrastructure (col. 6, lines 16-32; col. 3, lines 1-10).

Art Unit: 2132

Regarding claim 5, Puhl further discloses that the information associated with the end user comprises credit card information (col. 3, lines 21-23).

Regarding claim 6, Puhl further discloses providing notification on how to access the license, wherein the notification comprises a web page (col. 6, lines 31-33).

Regarding claim 13, Puhl does not disclose expressly that the end user receives a rejection notice if it is determined that the end user is unauthentic. However, Examiner takes Official Notice that the end user receiving a rejection notice if it is determined that the end user is unauthentic is well known in the art. It would have been obvious at the time of the invention was made to modify the Puhl method to include the step of receiving a rejection notice if it is determined that the end user is unauthentic .

66f ~~since~~ Examiner takes Official Notice that the end user receiving a rejection notice if it is determined that the end user is unauthentic is well known in the art. Such a rejection notice lets the end user know the status of a request.

Regarding claim 14, Puhl further discloses employing a financial institution to validate the information (col. 3, lines 21-23).

Regarding claim 22, the limitation "the license is substantially similar to a Public-Key Certificate in an Internet Public Key Infrastructure" (line 7) is interpreted as "the license is substantially similar in nature to a Public-Key Certificate in an Internet Public Key Infrastructure". Puhl discloses a system comprising: means for receiving an electronic request for a license that includes information associated with an end-user and an identifier associated with a software product (col. 6, lines 16-32); means for employing the information to authenticate the end-user (col. 6, lines 16-32); and means

Art Unit: 2132

for employing a Licensing Authority to digitally sign the license when the end-user is authentic (col. 6, lines 16-32; col. 5, lines 5-10), and wherein the license enables access to the software product. Since the license is generated by a trusted authority, and the license is signed and verified using a public key encryption algorithm, it is substantially similar in nature to a Public-Key Certificate in an Internet Public Key Infrastructure. Puhl discloses a certificate revocation list (CRL) listing license certificates that have been revoked (col. 7, lines 5-7); however, Puhl does not disclose how to access the CRL. Sudia discloses a certificate having an extension field that includes a URL to a CRL responder that provides revocation status information for a certificate (paragraphs 0381-0382, 0386); the revocation status information for a certificate is functionally equivalent to an additional license restriction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl license certificate to have an extension field that includes a URL to a CRL responder that provides revocation status information for a certificate, as taught by Sudia. The motivation for doing so would have been to facilitate checking of revocation status information for a certificate.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Sudia as applied to claim 1 above, and further in view of Cronic (US 2003/0156719). Puhl does not disclose using Email to request the license. Cronic discloses using Email to request a license (paragraph 0034). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl method such to use Email to request the license, as taught by Cronic. Email

Art Unit: 2132

is the easiest way to transmit a file to a computer when you do not have an established connection with the computer (paragraph 0035).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Sudia as applied to claim 1 above, and further in view of Mirsa et al (6,189,146). Puhl discloses that the entity requesting the license is a user. Puhl does not disclose that the entity requesting the license is a company. Mirsa discloses a licensing system in which a company can request a software license (col. 1, lines 34-45; col. 2, lines 32-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl method such that the entity requesting the license is a company, as taught by Mirsa, because it is common for corporations or firms to buy a site license. Accordingly, the information used to authenticate the person requesting a company license is company-related information.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Sudia as applied to claim 8 above, and further in view of "Wireless Application Protocol Public Key Infrastructure Definition".

Regarding claims 10-11, Puhl does not disclose that the license format is substantially similar to a X.509 format. The "Wireless Application Protocol Public Key Infrastructure Definition" reference discloses using X.509v3 format with Wireless Application Protocol Public Key Infrastructure (WAP PKI). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl

Art Unit: 2132

method to use X.509v3 format, as taught in the "Wireless Application Protocol Public Key Infrastructure Definition" reference, in order to leverage the existing Internet PKIs. In addition, any new format that requires major change to the installed base of certificate-processing products and CA infrastructure is unlikely to be easily adopted in a short timeframe (Section 1, page 5, last two paragraphs). Accordingly, the X.509v3 format includes an extension field comprising a hash value.

Regarding claim 12, Puhl further discloses that the license comprises a digital signature associated with the Licensing Authority, wherein the digital signature is created using the RSA algorithm (col. 5, lines 5-11; col. 2, line 11).

9. Claims 16-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Mirsa et al.

Regarding claims 16-17, Puhl discloses a system comprising: a client computer configured to provide an electronic request for a license that includes information associated with an end user and an identifier associated with a software product (col. 6, lines 16-32); a Web server configured to receive the electronic request and to employ the information to authenticate the end-user (col. 6, lines 16-32); a Licensing Authority configured to digitally sign the license and notify the client computer where to obtain the license if the end-user is authentic, wherein the license enables access to the software product (col. 6, lines 16-32; col. 3, lines 1-10). Puhl's teaching of using a Web server to receive the request and authenticate the user for the Licensing Authority is not precluded from the claim language.

Puhl discloses a software server receiving a request for the software product (fig. 3, step 226). Puhl does not disclose that the software server receives the license associated with the software product from the client computer, determines if the license is valid, and provides access to the software product if the license is valid. Mirsa discloses a software server that receives a license associated with a software product, determines if the license is valid by examining a signature associated with a Licensing Authority, and provides access to the software product if the license is valid (col. 13, line 65 – col. 14, line 48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl system such that the software server receives the license associated with the software product from the client computer, determines if the license is valid by examining a signature associated with the Licensing Authority, and provides access to the software product if the license is valid, as taught by Mirsa, in order to verify that the license is valid before enabling the software product.

Regarding claim 18, Puhl discloses a license revocation list from a Licensing Repository (col. 7, lines 3-7). Although Puhl does not disclose that the server utilize a license revocation list to determine if the license is valid, the feature is obvious by the combination of Puhl and Mirsa discussed above.

Regarding claim 19, Puhl further discloses that the client computer is further configured to receive notification of how to obtain the license; install the license; and employ the license to enable access to the software product (col. 6, lines 32-35).

Regarding claim 20, Puhl further discloses that the Licensing Authority operates substantially similar to a Certification Authority in a Public Key Infrastructure (col. 6, lines 16-32; col. 3, lines 1-10).

Regarding claim 24, Mirsa further discloses that receiving the digitally signed license comprises sending a license request to the client computer after receiving the request for the software product, and receiving the digitally signed license from the client computer in response to the license request (col. 14, lines 14-29).

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Mirsa as applied to claim 16 above, and further in view of "Wireless Application Protocol Public Key Infrastructure Definition". Puhl does not disclose that the license format is substantially similar to a X.509 format. The "Wireless Application Protocol Public Key Infrastructure Definition" reference discloses using X.509v3 format with Wireless Application Protocol Public Key Infrastructure (WAP PKI). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl method to use X.509v3 format, as taught in the "Wireless Application Protocol Public Key Infrastructure Definition" reference, in order to leverage the existing Internet PKIs. In addition, any new format that requires major change to the installed base of certificate-processing products and CA infrastructure is unlikely to be easily adopted in a short timeframe (Section 1, page 5, last two paragraphs).

Art Unit: 2132

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl in view of Mirsa as applied to claim 16 above, and further in view of Spagna et al (6,587,837). Mirsa discloses that the step of receiving the digitally signed license requires three transmissions: the user sends a request for the software product, the server sends a license request to the user, and the user sends the license to the server. Mirsa does not disclose that the user sends the license with the request for the software product. Spagna discloses a licensing system in which a user sends a license for a software product with the request for the software product (figures 1D and 10; col. 22, lines 25-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify combined method of Puhl and Mirsa such that the user sends the license with the request for the software product, as taught by Spagna, in order to reduce network traffic.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication No. 2005/0114653 to Sudia

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

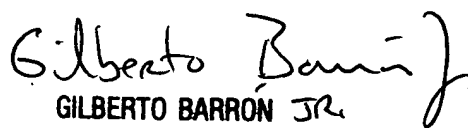
Application/Control Number: 10/609,344
Art Unit: 2132

Page 12

MD

Minh Dinh
Examiner
Art Unit 2132

MD
7/8/05


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100